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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/965,597	09/26/2001	Daniel S. Gluck	GLU-01	3506

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EXAMINER	
BORISSOV, IGOR N	

ART UNIT	PAPER NUMBER
3628	

MAIL DATE	DELIVERY MODE
01/28/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/965,597	GLUCK ET AL.	
	Examiner	Art Unit	
	Igor Borissov	3639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04/13/2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,4,6,15,17,18,23,26,28,37,39 and 40* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,4,6,15,17,18,23,26,28,37,39 and 40* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

Amendment received on 04/13/2007 is acknowledged and entered. Claims 2, 3, 5, 7-14, 16, 19-22, 24-25, 27, 29-36, 38, 41-49 have been canceled. Claims 1, 15, 17, 18, 23, 37, 39 and 40 have been amended. Claims 1, 4, 6, 15, 17, 18, 23, 26, 28, 37, 39 and 40 are currently pending in the application.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 4, 6, 15, 17, 18, 23, 26, 28, 37, 39 and 40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the following limitation: "contract becomes binding only if the aggregate number of a plurality of customers executing acquisition contracts reaches a threshold level" in step (i). The claim is silent what would happened if said aggregate number does not reach a threshold level, thereby rendering the claim indefinite. Same reasoning applied to the remaining claims.

Claim 17 recites: "The method of claim 1, in which *the costs of energy systems are reduced* by using the consulting system to organize customers in the database to advocate politically for regulatory changes, by automatically inviting customers to participate in lobbying activities, and coordinating such activities, including with environmental organizations, designed to persuade their local government to enact incentives that will lower the price of energy generation systems for them, and to enact legislation to require their local utility to buy back, at the retail rate, energy generated without causing pollution.", which is confusing. It is not clear how "advocating politically

for regulatory changes" can reduce the costs of energy systems. Same reasoning is applied to claim 39.

Claim 18 recites: "The method of claim 1, in which *the number of potential customers is increased* by using the consulting system to organize customers in the database to advocate politically for regulatory changes which reduce the cost of energy generation systems, by automatically inviting customers to participate in lobbying activities, and coordinating such activities, including with environmental organizations designed to persuade their local government to enact incentives that will lower the price of energy systems for them, and to enact legislation require their local utility to buy back, at the retail rate, energy generated without causing pollution.", which is confusing. It is not clear how "advocating politically for regulatory changes" can increase the number of potential customers. Same reasoning is applied to claim 40.

Apparatus (system) claim 23 recites:

" ...means within the system for querying a plurality of manufacturers' or sellers' databases...

means within the system for collecting and storing in the database selected portions of the specification data and pricing data...

means within the system for determining at least one volume discount price level...", which appears to be software modules. It is not clear to what extend software modules represent structural elements. Same reasoning is applied to the remaining system claims.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 23 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

An invention, which is eligible or patenting under 35 U.S.C. 101, is in the "useful arts" when it is a machine, manufacture, process or composition of matter, which produces a concrete, tangible, and useful result.

The claim, as currently recited, appears to be directed to software modules, which is nothing more than software or computer-executable instructions, or code per se. Therefore, the claim is considered to be directed to a non-statutory class of invention.

Claims 17, 18, 39 and 40 is rejected under 35 U.S.C. 101 because the claimed invention does not provide concrete and repeatable result.

In determining whether the claimed subject matter is statutory under 35 U.S.C. 101, a practical application test should be conducted to determine whether a "useful, concrete and tangible result" is accomplished. See *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1359-60, 50 USPQ2d 1447, 1452-53 (Fed. Cir. 1999); *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1600 (Fed. Cir. 1998).

An invention, which is eligible or patenting under 35 U.S.C. 101, is in the "useful arts" when it is a machine, manufacture, process or composition of matter, which produces a concrete, tangible, and useful result. The fundamental test for patent

eligibility is thus to determine whether the claimed invention produces a "useful, concrete and tangible result". The test for practical application as applied by the examiner involves the determination of the following factors"

(a) "Useful" – The Supreme Court in *Diamond v. Diehr* requires that the examiner look at the claimed invention as a whole and compare any asserted utility with the claimed invention to determine whether the asserted utility is accomplished. Applying utility case law the examiner will note that:

i. the utility need not be expressly recited in the claims, rather it may be inferred.

ii. if the utility is not asserted in the written description, then it must be well established.

(b) "Tangible" – Applying *In re Warmerdam*, 33 F.3d 1354, 31 USPQ2d 1754 (Fed. Cir. 1994), the examiner will determine whether there is simply a mathematical construct claimed, such as a disembodied data structure and method of making it. If so, the claim involves no more than a manipulation of an abstract idea and therefore, is nonstatutory under 35 U.S.C. 101. In *Warmerdam* the abstract idea of a data structure became capable of producing a useful result when it was fixed in a tangible medium, which enabled its functionality to be realized.

(c) "Concrete" – Another consideration is whether the invention produces a "concrete" result. Usually, this question arises when a result cannot be assured. An appropriate rejection under 35 U.S.C. 101 should be accompanied by a lack of enablement rejection, because the invention cannot operate as intended without undue experimentation.

Claims 17 and 39 require reducing the costs of energy by *advocating politically for regulatory changes, inviting customers to participate in lobbying activities, and coordinating such activities*. However, there is no guarantee that said activities will provide the expected result. Same reasoning applied to claims 18 and 40.

Claim Rejections - 35 USC § 103

Claim Rejections under 35 USC § 103 have been withdrawn.

Remarks

If any clarification regarding Claim Rejections - 35 USC § 112 and § 101 is required, Applicants are advised to contact the Examiner for said matter.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igor Borissov whose telephone number is 571-272-6801. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

IB
08/06/2007

IGOR N. BORISSOV
PRIMARY EXAMINER